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EXAMINER

SANDERS, STEPHEN

ART UNIT	PAPER NUMBER
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2139

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,138	Applicant(s) HE ET AL.	
	Examiner STEPHEN SANDERS	Art Unit 2139	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 9, 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 10-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action has been issued in response to Amendments to the Abstract and Claims and the Remarks filed July 9, 2008.

Claims 1-17 are pending, in which claims 1, and 5-9 are in independent form.

Applicant's amendments necessitated new ground(s) of rejection presented in this Office action, and are shown below. Subsequently, Applicant's arguments are not persuasive as they relate to the rejections of claims 1-9 under 35 U.S.C. 102 and therefore remain, as will be discussed below along with the rejections to claims 10-17. Accordingly, this action has been made FINAL.

Status of Claims:

Claims 1-17 are rejected under 35 U.S.C. 102(a).

Response to Amendment

Applicant's amendments to the Abstract and Claims have been received and entered. In light of the amendment to the Claims, the objection to the claims 2-4 are withdrawn. Additionally, in light of the amendment to the Claims, the rejections for claims 1, 3, and 5-9 under 35 U.S.C. 112 are withdrawn. Additionally, in light of the amendment to the Claims, the rejections for claims 1-9 under 35 U.S.C. 101 are withdrawn.

Response to Arguments

Applicant's arguments filed July 9, 2008 have been fully considered and are not persuasive as they relate to 35 U.S.C. 102. Regarding Applicant's argument pertaining

to the 35 U.S.C. 102(b) rejections on page 13, line 2, Examiner respectfully points out that Applicant cited "Jacobson" instead of "Nordman" for the U.S. Patent No. 6,061,346 cited on line 1. Additionally, Applicant's added claims (10—17), (misspelling of the phrase "at least on" instead of "at least one" on pages 9-10), which are also examined in light of Applicant's argument and are rejected under 35 U.S.C. 102(a) as shown below .

Claim Objections

1. Claims 10-17 are objected to because of the following informalities: misspelling of the phrase "at least on" instead of "at least one". Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-17 are rejected under 35 U.S.C. 102(a) as being anticipated by Schwartz et al, Patent No.: WO 01/90860 A2; Publication Date: Nov. 29, 2001 hereinafter Schwartz.

As to claim 1, the following is taught: "A communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method

comprising the acts of: extracting memory medium properties from the memory medium inserted in the device, sending said memory medium properties to the remote unit,”; and authenticating the memory medium by comparing said properties with the ones of a corresponding data carrier legally produced by a provider, before sending the additional data to the device.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; page 4, lines 4-8; page 5, lines 20-22; See claims starting page 16).

As to claim 2, the following is taught: “The communication method as claimed in claim 1, wherein the memory medium properties are written in a control data zone of the memory medium.” (Schwartz teaches: Abstract, Detailed Description of the Preferred Embodiment: page 4, lines 4-8; page 5, lines 6-11; See claims starting page 16).

As to claim 3, the following is taught: “The communication method as claimed in claim 1, further comprising an acts of blacklisting the device if the remote unit receives a number of requests higher than a predetermined threshold from said device containing a non-authenticated memory medium.” (Schwartz teaches: Detailed Description of the Preferred Embodiment: page 5, lines 20-25; See claims starting page 16).

As to claim 4, the following is taught: "The communication method as claimed in claim 1, wherein the remote unit is able to send different types of additional data as a function of the memory medium properties." (Schwartz teaches: Detailed Description of the Preferred Embodiment: page 13, line 27 to page 14, line 2; See claims starting page 16).

As to claim 5, the following is taught: "A communication system comprising a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said device and the remote unit communicating via a network, wherein the remote unit is able to retrieve memory medium properties from the memory medium inserted in the device, and"; "to authenticate said memory medium by comparing said memory medium properties with the ones of a corresponding memory medium legally produced by a provider, before sending the additional data to said device." (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; page 4, lines 4-8; page 5, lines 20-22; See claims starting page 16).

As to claim 6, the following is taught: "A remote unit for communicating with a device able to read a memory medium, the remote unit comprising additional data for the memory medium; means for retrieving memory medium properties from the memory medium inserted in the device, and means for authenticating said memory medium by comparing said memory medium

properties with the ones of a corresponding memory medium legally produced by a provider, before sending the additional data to said device.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 5, lines 6-11; page 5, lines 20-22; See claims starting page 16).

As to claim 7, the following is taught: “A device able to read a memory medium and to communicate with a remote unit comprising additional data for the memory medium, said device comprising means for extracting memory medium properties from the memory medium inserted in the device and means for sending said memory medium properties to the remote unit .” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 5, lines 9-11; See claims starting page 16).

As to claim 8, the following is taught: “A computer readable medium embodying a computer program; comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising acts of extracting memory medium properties from the memory medium inserted in the device, and sending said memory

medium properties to the remote unit.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 3, lines 1-10; page 5, lines 9-11; page 5 line 26 to page 12, line 26; See claims starting page 16).

As to claim 9, the following is taught: “A computer readable medium embodying a computer program comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of retrieving memory medium properties from the memory medium inserted in the device, and authenticating the memory medium by comparing said memory medium properties with the ones of a corresponding memory medium legally produced by a provider, before sending the additional data to the device.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 5, lines 6-11; page 5, lines 20-22; page 5, line 26 to page 12, line 26; See claims starting page 16).

As to claim 10, the following is taught: “The communication method of claim 1, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1

lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 11, the following is taught: "The communication method of claim 1, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 12, the following is taught: "The communication system of claim 5, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 13, the following is taught: "The communication system of claim 5, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 14, the following is taught: "The remote unit of claim 6, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 15, the following is taught: "The remote unit of claim 6, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 16, the following is taught: "The device of claim 7, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 17, the following is taught: "The device unit of claim 7, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Valerij et al, U.S. Patent No.: 5,790,662; Date of Patent: Aug. 4, 1998.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Sanders whose telephone number is 571-270-5308. The examiner can normally be reached on M - F; 7:30a.m. - 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on 571-272-4063. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen Sanders/
Examiner, Art Unit 2139

/Kristine Kincaid/
Supervisory Patent Examiner, Art
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